

Response to Office Action
SN 10/612,504

REMARKS

I. Amendments

A. Specification Amendments

The Applicant requests that paragraphs 0004, 0006, 0007, 0020 and the abstract be replaced with replacement paragraphs in order to clarify the pulse width informality pointed out by the Examiner. The full text of the desired replacement paragraphs is attached in which deleted words are struck through and added words are underlined.

B. Claim Amendments

Claims 1 has been amended to clarify that the laser sources are housed in the probes. This claim limitation is supported in the specification at paragraph 0021.

Claims 4-7 are amended as a result of the clarification of the pulse width informality.

Claim 23 has been amended to more particularly point out and distinctly claim that the first optical arrangement of the device claimed therein receives only a first laser beam. This claim limitation is supported in the specification at paragraph 0017.

Claims 30 and 32 are amended to cover only visible laser beams. This claim limitation is supported in the specification at paragraph 0022.

Attached is a marked-up listing of all the claims in which deleted words are struck through and added words are underlined.

II. Objection to Specification

The Examiner has objected to the specification for its use of the phrase "pulse width." As defined in the specification at paragraph 0021, a pulse width indicates the period of time between one pulse starting and the next pulse starting. This is also known in the art as the pulse repetition rate. Consequently, the Applicant has amended the specification and claims throughout the

Response to Office Action
SN 10/612,504

application to replace "pulse width" with "pulse repetition rate" to correct this informality.

Applicant respectfully submits that the Examiner's objection has been traversed and that it be withdrawn.

III. Claim Rejection Under 35 USC §112

Claim Amended to Correct Lack of Antecedent Basis

Claim 10 was rejected for lack of antecedent basis. Pursuant to a telephone conversation with the Examiner on December 20, 2004, the §112 rejection for claim 10 should have instead referred to claim 23. Claim 23 has been amended to more particularly point out and distinctly claim that the optical arrangement of the device claimed in claim 23 receives only a first laser beam.

Applicant respectfully submits that the Examiner's rejection has been traversed and that it be withdrawn.

IV. Claim Rejection Under 35 USC §102(e)

A. Gerdes Does Not Anticipate

The Examiner has rejected claims 1-18, 20-22, and 30-34 as being anticipated by US Patent No. 6,267,779 issued to Gerdes. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers, Inc. v. Union Oil Co. of California*, 2 USPQ2nd 1051 at 1053 (Fed. Cir. 1987).

In regards to claims 1-18 and 20-22, Gerdes does not disclose, either expressly or inherently, that the laser sources may be in the probe. Gerdes discloses that the laser sources are housed in a cabinet and that the laser beam is carried to the probe by means of a fiber optic cable. See FIG. 1, which illustrates the fiber optic cables attached to the cabinet and FIG. 4, which illustrates the laser sources attached to the fiber optic cables. See also column 5, line 14, column 8 lines 23-25, and column 9 lines 54-59 which disclose that the

Response to Office Action
SN 10/612,504

laser beams are transmitted to the probe via fiber optic cables, and that the laser sources are in the cabinet.

In contrast, Applicant's preferred embodiment provides that the laser sources are mounted within the probes. Applicant has amended Independent claim 1 to clarify that the laser sources are in the probes. See specification paragraph 0021. Therefore, Gerdes does not anticipate any of claims 1-18, 20-22 of the present invention (as amended) because Gerdes does not disclose one of Applicant's claimed structural elements, namely that the laser sources are in the probes.

With respect to amended claims 30-34, Gerdes does not anticipate these claims because Gerdes does not expressly disclose the use of only visible emissions. Instead, Gerdes discloses that at least one of the emissions is infrared. See Gerdes Abstract; column 4, lines 45-51; column 5 lines 8-11 and 35-40. Infrared emission (about 750 – 14000 nm) is invisible to the human eye, so in order to aim the infrared emission, Gerdes employs a probe with a visible emission coincident with the infrared emission. See Gerdes Abstract. But for the infrared emission, Gerdes would not need two probes. Therefore, Gerdes teaches away from the use of two visible emissions, since one must be invisible – the infrared beam – to satisfy the need for the invention. Therefore, Gerdes does not anticipate claims 30-34 as amended because each of those claims requires that the laser sources generate only visible light and Gerdes does not expressly or inherently disclose a device in which all the emissions are only in the visible range.

Because Gerdes does not disclose each and every element as set forth in the claims, either expressly or inherently, Gerdes does not anticipate Applicant's claimed invention and Applicant respectfully requests that this rejection be withdrawn.

Response to Office Action
SN 10/612,504

V. Claim Rejection Under 35 USC §103 –

Claims Not Obvious Because Cited Reference Does Not Suggest All Claim Limitations

The Examiner has rejected claims 19, 23-29 as being obvious in light of Gerdes. A claim is *prima facie* obvious only if the prior art reference (or references when combined) teach or suggest all the claim limitations. MPEP §2143.

Regarding claim 19, Applicant respectfully disagrees with the Examiner that Gerdes renders a plus-sign obvious. While Gerdes discloses that a wide variety of beam shapes can be used, Gerdes limits the variety to those that are "spread-out." See Gerdes Column 9, line 48. Further, Gerdes indicates that the width of the "spread out" pattern is approximately 4 mm. See Gerdes Column 8, line 44 and Column 9, line 46. This "spread-out" pattern follows because one purpose of Gerdes is to generate heat within the body, particularly joints, and joints are at least 4 mm in size. See Gerdes column 5, 1-11.

In contrast, the use of a plus sign enables the user to precisely target the beam to nearly a single point, namely the intersection of the lines. This is the opposite of the "spread out" beam pattern of Gerdes, which cannot be precisely aimed. Therefore, Gerdes actually teaches away from the use of a plus sign, and cannot render claim 19 obvious.

Applicant respectfully requests that this rejection be withdrawn because the cited references do not teach or suggest one of Applicant's claimed limitations and therefore no *prima facie* case has been established.

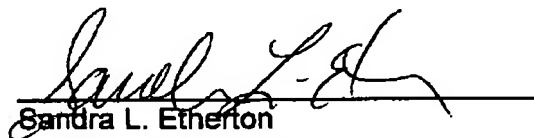
Regarding claims 23-29, Applicant has amended independent claim 23 to clarify that the laser sources are in the probes. The arguments of Section IV. A. of the Remarks are incorporated herein. Applicant believes that the amendment of the associated independent claim 23 renders this rejection moot. Therefore, Applicant respectfully requests that this rejection be withdrawn.

Response to Office Action
SN 10/612,504

VI. Conclusion

Applicant respectfully submits that all objections and rejections have been traversed, and that the application is in form for allowance. Applicant respectfully requests that the Examiner allow the application to proceed to allowance.

Respectfully submitted,



Sandra L. Etherton
Attorney for Applicant
Registration No. 36,982

Etherton Law Group, LLC
5555 East Van Buren Street
Suite 100
Phoenix, AZ 85008
tel: 602-681-3331
fax: 602-681-3339